

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DEAN L. SICKING and BRIAN G. PFEIFER

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Appeal No. 98-1461  
Application No. 08/335,153<sup>1</sup>

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ON BRIEF

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Before MEISTER, ABRAMS, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 17, 19 through 22, 25 and 27.<sup>2</sup> Claims 1 through 5, 18, 23, 24 and 26 have been allowed. Claims 6

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<sup>1</sup> Application for patent filed November 7, 1994.

<sup>2</sup> Claim 22 was amended subsequent to the final rejection. The examiner has withdrawn the 35 U.S.C. § 112, second paragraph, rejection of claim 22.

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through 16 have been withdrawn from consideration under 37 CFR  
§ 1.142(b) as being drawn to a nonelected invention.

We REVERSE.

BACKGROUND

The appellants' invention relates to a guardrail cutting terminal. An understanding of the invention can be derived from a reading of exemplary claims 17 and 25, which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bronstad 1987	4,655,434	Apr. 7,
Sicking et al. 7, 1992 (Sicking)	5,078,366	Jan.

Claim 21 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.<sup>3</sup>

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<sup>3</sup> This rejection, set forth in the final rejection, was not repeated in the examiner's answer in section 11, Grounds of Rejection. However, the examiner in section 13 of the answer, Response to argument, did set forth his position why claim 21 was considered to be vague and indefinite. Accordingly, we will treat this rejection as being maintained by the examiner and subject to our review.

Claims 17, 20 through 22 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bronstad.

Claims 17, 19 through 22, 25 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sicking in view of Bronstad.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 17, mailed March 17, 1997) and the examiner's answer (Paper No. 25, mailed December 8, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 24, filed November 13, 1997) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the

examiner. As a consequence of our review, we make the determinations which follow.

**The indefiniteness issue**

We will not sustain the rejection of claim 21 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner determined (final rejection, p. 2) that the phrase "partly slits the guardrail<sup>[4]</sup> without separating the cutable member into parts" was vague and indefinite since the function of a slit is to separate portions of a member. The examiner takes the position (answer, p. 6) that slitting refers to a separation, therefore the claimed phrase is contradictory and therefore vague and indefinite.

The appellants argue (brief, p. 14) that the examiner is reading the word "slit" too narrowly. We agree. In that regard, it is our opinion that an artisan would have no difficulty at all in understanding the metes and bounds<sup>5</sup> of claim 21. Specifically, we see claim 21 as plainly reciting that the cutting section **partly** slits the cutable member, that is the cutting section does not slit the cutable member into separate parts. Accordingly, claim 21 sets forth the claimed

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<sup>4</sup> We interpret the term "guardrail" as being "cutable member" for proper antecedent basis in understanding this phrase. The appellants should amend claim 21 to directly reflect this interpretation.

<sup>5</sup> See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

invention with a reasonable degree of precision and particularity.

For the reasons stated above, the decision of the examiner to reject claim 21 under 35 U.S.C. § 112, second paragraph, is reversed.

**The anticipation issue**

We will not sustain the rejection of claims 17, 20 through 22 and 25 under 35 U.S.C. § 102(b).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference.

The appellants argue (brief, pp. 17 and 19) that independent claims 17 and 25 are not anticipated by Bronstad

since Bronstad does not disclose the recited "cutting means." Specifically, the appellants contend that the claimed "cutting means" is not readable on the bolts 50 of Bronstad.

The examiner (answer, pp. 6-7) did not find this argument to be persuasive since the examiner considered the claimed "cutting means" to be readable on the bolts 50 of Bronstad.

We agree with the appellants that the claimed "cutting means" is not readable on the bolts 50 of Bronstad. In that regard, the claimed "cutting means" must be given its broadest reasonable interpretation consistent with the specification, and must be read in light of the specification as it would be interpreted by one of ordinary skill in the art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). In this case, the specification discloses (1) the cutters are wedge shaped (p. 7), and (2) the cutters slice the rail 16 with a "shearing" action. In our view, an artisan would readily recognize the basic difference between cutting as disclosed in this application and the shredding disclosed by Bronstad. Accordingly, it is our determination that the

claimed "cutting means" is not readable on the bolts 50 of Bronstad since the bolts 50 will shred out rail material, not "cut" the rail material.

For the reasons stated above, the decision of the examiner to reject claims 17, 20 through 22 and 25 under 35 U.S.C. § 102(b) is reversed.

**The obviousness rejection**

We will not sustain the rejection of claims 17, 19 through 22, 25 and 27 under 35 U.S.C. § 103.

The examiner's rejection is premised on the theory that Bronstad discloses "cutting means" and that it would have been obvious to add those "cutting means" to the guardrail terminal of Sicking. However, this rejection must fail since Bronstad does not disclose "cutting means" as recited in the claims under appeal for the reasons pointed out above. Thus, the combined teachings of the applied prior art would not have

suggested to one of ordinary skill in the art the claimed  
"cutting means."

Since all the limitations of the appealed claims are not  
suggested by the applied prior art for the reasons set forth  
above, the decision of the examiner to reject claims 17, 19  
through 22, 25 and 27 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 21 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 17, 20 through 22 and 25 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 17, 19 through 22, 25 and 27 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPLICATION NO. 08/335,153

APJ NASE

APJ MEISTER

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 04 Feb 99

**FINAL TYPED:**